

Response dated July 19, 2004
Response to Notice of Non-Compliant
Amendment dated June 17, 2004

Appl. No. 09/727,516

REMARKS

This is a Response to the Notice of Non-Compliant Amendment mailed June 17, 2004. Applicants submit that the substitute Abstract submitted in clean form with the Amendment filed May 12, 2004 was in compliance with Rule 1.121 as discussed in detail in 68 Fed. Reg. 38611, 38616 (see attached page therefrom). The Notice of Non-Compliant Amendment dated June 17, 2004 was therefore in error. Nevertheless, in order to expedite prosecution, this Response includes a marked-up copy of the Abstract of the Disclosure.

Further examination on the merits is respectfully requested.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Percy L. Square (Reg. No. 51,084) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

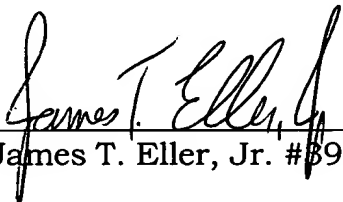
Response dated July 19, 2004
Response to Notice of Non-Compliant
Amendment dated June 17, 2004


Appl. No. 09/727,516

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By 
James T. Eller, Jr. #39,538


JTE/PLS:jls
3430-0149P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

Attachments: Marked-Up Version of Abstract
68 Federal Register 38616

(Rev. 09/30/03)

in the margin of amendments to the specification or claims. Paragraph (b)(2)(ii) has also been revised to eliminate the requirement to provide a clean version of the replacement section. Examples of typical amendments in the revised practice will be available on the Office's Internet Web site (<http://www.uspto.gov>).

Amendments to the abstract of the disclosure should be included in that portion of applicant's amendment document which presents amendments to the specification. Where the amendments to the abstract are minor in nature, *i.e.*, purely grammatical in nature or a limited number of additions or deletions of subject matter are presented, the abstract should be provided as a marked-up version using strike-through and underlining as the methods to show all changes relative to the immediate prior version. Where the abstract is being substantially rewritten and the amended abstract bears little or no resemblance to the previously filed version of the abstract, a new (substitute) abstract may be provided in clean form accompanied by an instruction for the cancellation of the previous version of the abstract. The text of the new abstract must not be underlined. It would be counterproductive for applicant to prepare and provide an abstract so riddled with strike-through and underlining that its meaning and language are obscured from view and comprehension. Whether supplying a marked-up version of a previous abstract or a clean form new abstract, the abstract must still comply with § 1.72(b) requirements regarding length and placement of the abstract on a separate sheet of paper.

Paragraph (b)(3) has been rewritten to reflect a concurrent revision to § 1.125. Although the requirement for a clean form, or version without markings, of a replacement paragraph or section of the specification has been eliminated, the Office maintains the need for a clean form and a marked-up version of a substitute specification. Since substitute specifications generally include many changes, the clean version will assist the examiner to view the substitute specification without distractions from the markings. The marked-up version will assist the examiner in readily ascertaining those changes being made and to alert the examiner to the presence of any new matter. Amendment by substitute specification is permissible where, as set forth in § 1.121(b)(3)(i), an instruction to replace the specification is submitted and, as set forth in § 1.121(b)(3)(ii), the substitute specification is provided in compliance

with §§ 1.125(b) and (c). Section 1.125(b) continues to require that a substitute specification be accompanied by a statement that it includes no new matter. Section 1.125(c) now requires that two versions of the substitute specification be provided. One version must be submitted with markings showing all changes (strike-through, or in some cases double brackets, indicating subject matter being deleted and underlining indicating subject matter being added) relative to the immediate prior version of the specification of record. An accompanying clean version (without markings) must also be supplied.

Strike-through and underlining features are available in most, if not all, commercially available word processing systems. Often times these features are located and activated through a "format" menu, which allows the user to create text, which is struck through or underlined, or highlight text already presented. In the latter case, previously presented text may be selected and strike-through or underlining engaged such that the text is marked in the desired fashion. Additionally, some word processing systems offer editorial tools that permit a user to automatically "track changes" made when editing a document. These editorial tools frequently use strike-through as the manner in which to indicate deleted subject matter and underlining as the manner in which to indicate added subject matter. To clearly identify a line or a section of a document in which changes have been made, these editorial tools may place a vertical line in the left or right margin of the document directly adjacent to the line or section of text in which the changes occur. The presence of such vertical lines in the left or right margin of a replacement paragraph or section of the specification or a marked-up version of a substitute specification is acceptable.

Deleted subject matter may also be indicated in some circumstances by double brackets placed at the beginning and the end of the deleted text. Double brackets must be used if the deleted text would not be easily perceived using strike-through. For example, changing "4 corners" to "three corners" should be indicated by "three [[4]] corners" rather than "three4 corners" (the strike-through being obscured by the horizontal line in the "4"). Double brackets may also be used to indicate the deletion of five or fewer consecutive characters. Alternatively, the use of strike-through and/or underlining to show the deletion and/or addition of punctuation marks or difficult to perceive characters may, in the

replacement paragraph or rewritten claim, encompass portions of text before and after the punctuation marks or characters. Examples of typical amendments in the revised format will be available on the Office's Internet Web site (<http://www.uspto.gov>).

The prior requirement made in §§ 1.121(b)(1)(ii) and (b)(2)(ii) to provide a clean form, or version without markings, of a replacement paragraph or section to the specification has been eliminated.

Paragraph (b)(4) remains unchanged.

New § 1.121(b)(5) has been added to provide that once a paragraph, section, or specification is amended in a first amendment document, re-presentation of the amended material in subsequent amendment documents is not necessary unless it is amended again or a substitute specification is provided.

Paragraphs (c)(1) through (c)(3) have been replaced with revised §§ 1.121(c) and (c)(1) through (c)(5). Paragraph (c) as revised provides for a total rewriting of a claim each time the claim is amended, including markings to show the changes being made relative to the immediate prior version of the claim, except when the claim is being canceled. Section 1.121(c) also requires submitting a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, and the status of each and every claim in every amendment document that includes an amendment to the claims. This listing, if entered, replaces all prior versions of the claims in the application. Inclusion of the claim status is required for each claim in each claim listing and must be indicated in a parenthetical expression following the claim number. The status of all claims in the application, even those previously canceled or withdrawn, must be indicated in the claim listing.

The status of each claim included in the claim listing must be described by one of the following seven defined identifiers in parentheses after the claim number:

- (Original): Claim filed with the application
- (Currently amended): Claim being amended in the current amendment document
- (Canceled): Claim deleted from the application.
- (Withdrawn): Claim still in the application, but in a non-elected status.
- (Previously presented): Claim added or amended in an earlier amendment document.
- (New): Claim being added in the current amendment document.